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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,563	06/30/2003	Michael J. Berardi	60655.0100	2297

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EXAMINER

HESS, DANIEL A

ART UNIT	PAPER NUMBER
2876	

MAIL DATE	DELIVERY MODE
06/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/611,563

Applicant(s)

BERARDI ET AL.

Examiner

Daniel A. Hess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-15, 19, 23-44 and 46-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-15, 19, 23, 30-44 and 46-62 is/are rejected.
- 7) ☒ Claim(s) 24-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/28/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to Applicant's filing of 2/26/2007, which has been entered into the electronic file of record.

The Examiner neglected in a previous action to make a double patenting rejection based on certain similar cases. These would be necessary so that the appropriate Terminal Disclaimers can be filed. Other than these, the Examiner withdraws all rejections on the merits, which means that the present case may be nearing allowability.

Since the Examiner did not make these double patenting rejections earlier in the prosecution, **the present action is a second non-final.**

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 7-15, 19, 23, 30-44 and 46-62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 41 (and other claims) of U.S. Patent No. 7,070,112. Although the conflicting claims are not identical, they are not patentably distinct from each other because the basic concept of a transparent card, combined with a machine recognizable compound that is infrared blocking and which generally covers the extent of the card, is shared in common in both the patent and the Instant Application.

The limitations that led patent 7,070,112 to be allowed are similar to those in the independent claims of the Instant Application. The differences between claims 1-4, 7-15, 19, 23, 30-44 and 46-62 of the present case and that of the patent are obvious modifications around the same concept of a transparent card combined with a machine recognizable compound that is infrared blocking and which generally covers the extent of the card.

Claims 1-4, 7-15, 19, 23, 30-44 and 46-62 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 116 of copending Application No. 10/394,914 in view of Tuttle et al. (US 5,988,510).

Claim 116 of copending Application No. 10/394,914 has the basic concept of a transparent card, combined with a machine recognizable compound that is infrared blocking and which generally covers the extent of the card.

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Tuttle teaches (see column 7, lines 3-5), a card with radio frequency communication with an interrogator. This occurs through a transponder (column 9, line 11).

In view of Tuttle's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known transponder in the card because this greatly enhances the functionality of the card and allows for fact and even contactless transactions (such as paying for gasoline by waving the card).

Other differences are obvious modifications around the same concept of a transparent card combined with a machine recognizable compound that is infrared blocking and which generally covers the extent of the card.

This is a provisional obviousness-type double patenting rejection.

Claims 1-4, 7-15, 19, 23, 30-44 and 46-62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 22 of U.S. Patent No. 6,749,123 in view of Tuttle.

Claim 22 of the patent has the basic concept of a transparent card, combined with a machine recognizable compound that is infrared blocking and which generally covers the extent of the card.

Tuttle teaches (see column 7, lines 3-5), a card with radio frequency communication with an interrogator. This occurs through a transponder (column 9, line 11).

In view of Tuttle's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known transponder in the card

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because this greatly enhances the functionality of the card and allows for fact and even contactless transactions (such as paying for gasoline by waving the card).

Other differences are obvious modifications around the same concept of a transparent card combined with a machine recognizable compound that is infrared blocking and which generally covers the extent of the card.

Claims 1-4, 7-15, 19, 23, 30-44 and 46-62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 20 of U.S. Patent No. 6,764,014 in view of Tuttle.

Claim 20 of the patent has the basic concept of a transparent card, combined with a machine recognizable compound that is infrared blocking and which generally covers the extent of the card.

Tuttle teaches (see column 7, lines 3-5), a card with radio frequency communication with an interrogator. This occurs through a transponder (column 9, line 11).

In view of Tuttle's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known transponder in the card because this greatly enhances the functionality of the card and allows for fact and even contactless transactions (such as paying for gasoline by waving the card).

Other differences are obvious modifications around the same concept of a transparent card combined with a machine recognizable compound that is infrared blocking and which generally covers the extent of the card.

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Claims 1-4, 7-15, 19, 23, 30-44 and 46-62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,581,839 in view of Tuttle.

Claim 21 of the patent has the basic concept of a transparent card, combined with a machine recognizable compound that is infrared blocking and which generally covers the extent of the card.

Tuttle teaches (see column 7, lines 3-5), a card with radio frequency communication with an interrogator. This occurs through a transponder (column 9, line 11).

In view of Tuttle's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known transponder in the card because this greatly enhances the functionality of the card and allows for fact and even contactless transactions (such as paying for gasoline by waving the card).

Other differences are obvious modifications around the same concept of a transparent card combined with a machine recognizable compound that is infrared blocking and which generally covers the extent of the card.

Response to Amendment

The Examiner takes the position that the present amendment overcomes the Examiner's rejection made in the Office Action mailed 1/8/2007.

The Examiner agrees with and concedes the Applicant's point that the newly added limitation that the infrared blocking material is 'covering an outer surface of said portion of said

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card' overcomes the rejection of 1/8/2007. Indeed, there would be no reason or purpose to put an adhesive on the outside of a card.

In addition, the Examiner further realizes that not all acrylic are infrared blocking, and indeed there is a possibility that the Examiner's combination might not block infrared, depending on the type of acrylic. This explains the Applicant's observations, as described by the Applicant: "As suggested by the Examiner, if transaction cards included Acrylic as a component of the adhesive, then the transparent transaction cards should have been recognized in the ATM devices. Unfortunately, such cards are not recognized by the ATM device."

Allowable Subject Matter

Claims 24-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to teach or fairly suggest a transparent card having two transponders, wherein there is a transponder system protocol/sequence controller configured to control the order of operation of the first transponder, second transponder, transponder system authentication circuit and transponder system database, the protocol sequence controller being in communication with at least one of said first transponder, second transponder, authentication circuit and transponder system database.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

5/20/2007



DANIEL HESS
PRIMARY PATENT EXAMINER